

REMARKS

Reconsideration and continued examination of this reissue application are respectfully requested. The amendments to claims 28 and 31 are fully supported by the original application. For instance, see column 4, line 64 et. seq. of the '305 patent. Accordingly, no questions of new matter should arise and entry of this amendment is respectfully requested.

In the Office Action, the Examiner, at page 2, contends that the reissue oath or declaration is defective because it fails to particularly specify the errors and/or how the errors relied upon arose or occurred as required under 37 C.F.R. § 1.175(a)(5). The Examiner further cites the legal decision of Hewlett-Packard v. Bauche & Lomb, 11 U.S.P.Q.2d 1750, 1758 (Fed. Cir. 1989) for support of his position. The Examiner also rejects claims 1-55 based upon the alleged defective reissue declaration under 37 C.F.R. § 251. For the following reasons, the objection and rejection are respectfully traversed.

As indicated in the reissue declaration of the inventors, the subject matter now set forth in claims 28-55 was not pursued during the prosecution of the application leading to the '305 patent based on a misunderstanding or error of the patent counsel for the assignee. See paragraph 3 of said reissue declaration. The inventors understood that the currently claimed subject matter was going to be part of the claimed invention in original application, which was a continuation-in-part application. While the undersigned believes a supplemental declaration further explaining how the error occurred is unnecessary, a supplemental declaration can be submitted if the Examiner still believes one is necessary. In view of this information, this objection and rejection should be withdrawn.

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The Examiner then rejects claims 28-55 under 35 U.S.C. § 251 contending that these claims are not "for the invention disclosed in the original patent." To support the Examiner's position, the Examiner cites several legal decisions, in particular, In re Rowand, 187 U.S.P.Q. 487 (C.C.P.A. 1975); In re Orita, 193 U.S.P.Q. 145 (C.C.P.A. 1977); and In re Mead, 198 U.S.P.Q. 412 (C.C.P.A. 1978). The Examiner further states that the reissue application presents claims to species not claimed in the original patent and thus may be rejected for lack of defect in the original patent and lack of error in obtaining the original patent. The Examiner makes reference to MPEP § 1450. The Examiner concludes by stating "the reissue claims must be drawn to the coating composition to which the patent and claims were limited." For the following reasons, this rejection is respectfully traversed.

The Examiner argues that claims 28-55 are not directed to the invention disclosed in the original patent and cites three legal decisions to support his argument. However, one decision cited by the Examiner, In re Mead, clearly ruled that "the entire disclosure, not just the claims, is considered in determining what the patentee intended to claim and what invention the patent discloses." 198 U.S.P.Q. 412, 416 (CCPA 1978). In fact, the court went on to determine that a review of the record showed that the original and the appealed claims were directed to embodiments of the invention disclosed in the specification. Furthermore, in In re Rowand, the court in deciding whether the reissue claims were for the invention disclosed in the original patent, not only looked at the claims but the entire disclosure including the specification. Accordingly, the Examiner's determination of whether the reissue claims are for the invention disclosed in the original patent must include a review of not only the claims in the original patent but the entire

disclosure, including the specification. From such a review, the evidence is clear that support for claims 28-55 is present in the original patent application as explained in the reissue declaration of the inventors. Further, the Examiner does not seem to dispute the fact that there is support in the original patent application. Based on this evidence and the case law, the Examiner's rejection on this point should be withdrawn.

In addition, with regard to the Examiner's argument that Applicants have failed to file a divisional application, Applicants respond as follows. To begin with, the original application was filed as a U.S. application pursuant to 35 U.S.C. § 371. In other words, the application was part of a national phase entry from a PCT application. All of the claims that were filed in the PCT application were present when entry into the national phase occurred. There was no restriction requirement entered in the original application. Since no restriction requirement was entered, it would not have been customary, or at least not typical practice, for applicants to file any divisional applications. The subject matter recited in claims 28-55 were not subject to a restriction requirement in the original patent application and thus the Examiner's argument that a divisional application should have been filed is not applicable to the facts in this reissue application. Furthermore, the facts in In re Orita are not applicable since In re Orita specifically dealt with the situation where a restriction requirement was entered and Applicants did not file a divisional application for the non-elected subject matter. Accordingly, this aspect of the rejection should also be withdrawn.

With regard to the Examiner's reliance on MPEP § 1450, and the argument that the claims must be drawn to a coating composition, the applicants respond as follows.

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The section of the MPEP referred to by the Examiner cites for support the legal decision of In re Rowand which was discussed above. In this decision the court looked not only to the claims but to the entire disclosure of the original patent, including the specification, to determine whether the reissue claims were for an invention disclosed in the original patent. Furthermore, the claims set forth in the original patent relate to a gaseous composition and claims 28-32 relate to a gaseous composition. Claims 34-38 relate to a film made from this gaseous composition and claims 39-49 relate to an article having a substrate and the film of claims 33-38. Accordingly, all of these claims relate to the same invention due to their interrelationship. Furthermore, MPEP § 1412.01 states clearly that reissue claims must be for the same invention as that disclosed in the original patent but "this does not mean that the invention claimed in the reissue must have been claimed in the original patent" Moreover, this section continues by stating that the entire disclosure, not just the claims, is considered in determining what the patentee objectively intended as his invention. Clearly, the patent specification shows support for claims 28-55 under the subheadings "DISCUSSION OF THE INVENTION" and "DESCRIPTION OF THE PREFERRED EMBODIMENTS." Accordingly, it is clear that Applicants have satisfied the requirements of 35 U.S.C. § 251 and that the rejection in view of MPEP § 1450 should be withdrawn.

Finally, at page 3 of the Office Action, the Examiner rejects claims 28-55 under 35 U.S.C. § 251. The Examiner contends that the original application contains claims to a coating composition which were subsequently rejected as being unsupported by the original specification. The Examiner further points out that in response to this rejection, Applicants limited the claims to compositions now recited in claim 1 of the patent and the

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present reissue claims expand the scope of the invention wherein the "recapture rule" is applicable. For the following reasons, this rejection is respectfully traversed.

Applicants first point out that claims 33-49 were not part of any subject matter rejected by the Examiner in the original application and accordingly the recapture rule does not apply to these claims.

Furthermore, with respect to claims 28-32, the independent claims within this group have been amended to recite the presence of a precursor of silicon oxide having the specific formula set forth in claim 1 of the '305 patent. In addition, these same claims have been amended to recite the other physical parameters of the gaseous composition recited in claim 1 of the '305 patent. Accordingly, this rejection should be withdrawn.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 06-0916. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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